

REMARKS

Claims 1 to 18, 67 and 71 to 85 are currently pending. In view of the following remarks, reconsideration and withdrawal of the rejection is respectfully requested.

Applicants note that the Examiner has not examined pending claims 71 to 85 as presented in the Amendment of August 19, 2005, the filing of which was acknowledged in the present Action. In this respect, applicants' submit that the finality of the rejection is not proper, and to the extent that the claims are deemed not to be in condition for allowance, withdrawal of the finality of the rejection is hereby requested.

REJECTION UNDER 35 U.S.C. § 102(b)

The Examiner has rejected claims 1 to 18 and 67 as being anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 3,635,856 to Kaneko et al. (hereinafter "Kaneko") "as affirmed by" the Mitsubishi-Kagaku internet publication entitled "Introduction of Sugar Esters" (hereinafter "Mitsubishi"). (Action, p. 2-3). This rejection is respectfully traversed for at least two reasons: (1) the combination of Kaneko with Mitsubishi is improper; and (2) the present claims are patentable over Kaneko and the combination of Kaneko and Mitsubishi.

A) Combination of Kaneko and Mitsubishi is Improper

The present rejection is respectfully traversed as Kaneko and Mitsubishi cannot be combined for anticipatory purposes. In general "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). However, an additional reference may be cited in an anticipatory rejection to prove that the primary reference contains an enabled disclosure, or to explain the meaning of a term used in the primary reference, or to show that a characteristic not disclosed in the primary reference is inherent. MPEP § 2131.01. Mitsubishi does none of these.

The Examiner cites Mitsubishi to "affirm" the structure of the saccharide ester disclosed in Kaneko. (Action, p.3). The Examiner does not explain how the Mitsubishi publication in 2002 is relevant to the Kaneko publication from 1979, or why or how the disclosure in Mitsubishi should be interpreted as disclosing some inherent characteristic of the material in Kaneko. The disclosure of Mitsubishi does not prove that Kaneko contains an enabled disclosure, explain the meaning of a term used in Kaneko, or demonstrate an inherent characteristic of Kaneko. Accordingly, the citation of Mitsubishi in combination with Kaneko in an anticipatory rejection is improper.

**B) Claims 1 to 18 and 67 are Not Anticipated by Kaneko or the
Combination of Kaneko and Mitsubishi**

The present rejection is respectfully traversed as claims 1 to 18 and 67 are not anticipated by Kaneko, and assuming *arguendo* that the combination of Kaneko and Mitsubishi is proper (which it is not), the present claims are also not anticipated by such combination.

The Examiner contends that the present claims are anticipated by Kaneko as the A substituents of Formula (I) are not limited to esters of Structure (I); thus, the ester-substituted sugars of Kaneko are alleged to be "substantially identical" to those of Formula (I). (Action, p.3-4). However, the present claims are directed to a process which uses a composition in which at least 50% of the compounds of Formula (I) are limited to those ortho-substituted with the ester of Structure (I). Thus, Kaneko clearly fails to disclose sugar mixtures that do contain octa-ester substituted sugars, which are required by the present claims. Kaneko's failure to disclose this limitation was acknowledged by the Examiner in failing to controvert the assertion of same in the Declaration of inventor Durrenberger. Accordingly, the present claims are not anticipated by Kaneko for at least this rationale.

As noted above, Mitsubishi discloses mixtures of several sugars, but **none** of the sugars disclosed in Mitsubishi are octa-ester substituted sugars, much less compositions wherein at least 50% of such sugars are octa-ester substituted. It follows that the combination of Mitsubishi with Kaneko, even if such combination were proper (which it is not), does not cure Kaneko's lack of disclosure regarding

octa-ester substituted sugars. Accordingly, the present claims are not anticipated by the combination of Kaneko with Mitsubishi for at least this rationale.

C) Application of *In re Casey* and *In re Otto* is Inopposite

Applicants note that the Examiner incorrectly cites *In re Casey* and *In re Otto* in rejecting claims 2 to 14; the Examiner asserts that the "intended use" allegedly recited in such claims does not "patentably distinguish the claimed invention from the prior art" as such intended use does not "result in a structural difference between the claimed invention and the prior art". (Action, p. 3).

Applicants note that the MPEP expressly states that *In re Casey* and *In re Otto* are "limited to claims directed to machinery which works upon an article or material in its intended use". MPEP § 2115. The present process claims are clearly not directed to machinery. Further, even if the holdings of such cases were applicable (which they are not), claims 2 to 14 define the amount of saccharide ester present in the composition by the effect that such ester has on the composition produced, not on any "intended use" of the composition itself. Accordingly, the application of *In re Casey* and *In re Otto* to the present claims is inopposite, and certainly does not support the Examiner's rejection.

D) Claims 1 to 18 and 67 are Patentably Non-obvious in view of Kaneko or the Combination of Kaneko and Mitsubishi

The present rejection is respectfully traversed as claims 1 to 18 and 67 are patentably non-obvious in view of Kaneko, and further in view of the

combination of Kaneko and Mitsubishi.¹

As noted above, Kaneko and Mitsubishi do not disclose the use of octa-ester substituted sugars. Kaneko itself does not contain any suggestion or motivation to modify the composition disclosed therein or to combine same with any other reference to produce the instantly claimed process; in fact, Kaneko teaches away from the use of octa-ester substituted sugars in an extrusion process by exemplifying and claiming only mono and di-ester substituted sugars, which the Examiner has acknowledged in failing to controvert the assertion of same in the Declaration of inventor Durrenberger.

Mitsubishi also does not contain any suggestion or motivation to combine same with Kaneko to produce the instantly claimed process. Mitsubishi discloses sugar mixtures having an HLB range of from 1 to 16. Mitsubishi discloses that HLB values decrease when increasing the amount of higher substituted sugars in the mixture; the mixture with the lowest HLB value of 1 is that which contains the largest proportion of higher substituted sugars out of all the sugar mixtures disclosed therein. However, even this mixture does not contain any octa-ester substituted sugars. Thus, even if Mitsubishi were prior art, its disclosure (either alone or in combination with Kaneko) does not suggest the use in an extrusion process of compositions using sugar mixtures containing at least 50% octa-ester substituted sugars.

¹ Applicants do not concede that Mitsubishi is prior art to the present invention, but nevertheless, the present invention is shown herein to distinguish patentably over same.

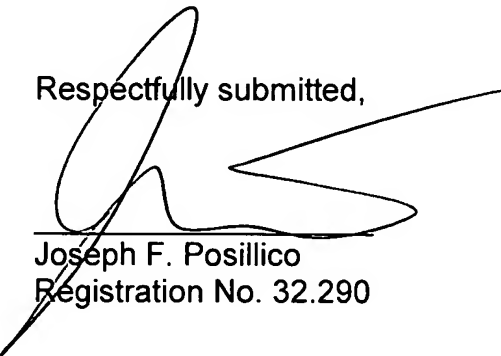
CONCLUSION

In view of the foregoing remarks, applicants assert that the present claims are in condition for allowance and request that the Office issue a Notice of Allowance at the earliest possible date.

The Office is invited to contact Applicants' undersigned counsel by telephone in order to further the prosecution of this case in any way.

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Respectfully submitted,



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